IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Ex Parte:	STEELE, SCOTT
Application Number:	09/414,121
Filing Date:	October 8, 1999
Title:	Remotely Configurable Multimedia Entertainment and Information System With Location Based Advertising
Group:	3622
Examiner:	RAQUEL ALVAREZ

REPLY BRIEF ON BEHALF OF APPELLANTS UNDER 37 CFR 41.41

Valerie M. Davis
Attorney of Record
Motorola, Inc.
Intellectual Property Section
Law Department
1303 E. Algonquin Rd.
Schaumburg, IL 60196

Telephone: 847-576-6733
Facsimile: 847-576-0721

Electronic Submittal Date: May 14, 2007

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I. STATUS OF CLAIMS

Claims 3, 4, 9, 10, 12, 14, 18, 20, 21 and 23-27 have been canceled. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 remain in the application. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 are being appealed. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 stand or fall together.

In a Final Office Action dated January 14, 2005, the Examiner rejected Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (USPN 6,183,366) in view of Hall (USPN 6,026,375), and rejected Claims 7, 8, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (USPN 6,183,366) in view of Hall (USPN 6,026,375) and further in view of Titmuss et al. (WO 98/47295).

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 are patentable under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall?

B. Whether Claims 7, 8, 15 and 16 are patentable under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall and further in view of Titmuss et al.?

III. ARGUMENT

A. Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 are rejected under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall.

Regarding independent Claims 1 and 13, even in lieu of the Examiner's Answer to Appeal Brief file on March 12, 2007, Appellants continue to contend that limitations are missing from the combined teachings of the Goldberg, et al. and Hall references.

More particularly, Claims 1 and 13 require "terminating the advertisements upon reaching the quota", which is not taught or suggested in the combined teachings of Goldberg, et al. and Hall. In response to Appellant's Appeal Brief, the Examiner's Answer states at pages 7-8 that "With respect to terminating advertisements upon reaching a quota. The Examiner wants to point out that the system of Goldberg on col. 29, lines 21-52 teaches the user receiving free or reduced Internet services for viewing advertisements. In such a systems as the one described in Goldberg it would make sense and would have been obvious for the advertisements to be terminated when the users have satisfied his or her thresholds required to receive the free or discounted service." Appellants disagree.

First, there are not thresholds for advertisements taught in Goldberg, et al. and this reference actually teaches away from terminating advertisements, even in col. 29, lines 21-52. Goldberg, et al. instead teaches repeated downloading of the advertisements, *see* col. 29, lines 14-20 and 36-39; "the game/advertisement web site 308 contacts the user's Internet service provider and arranges to subsidize the user's Internet service charges in return for the gaming advertisement web site 308 being able to *repeatedly download to the user's Internet client node*, . . unrequested information such as advertising for presentation to the user; wherein this daemon

allows the game/advertisement web site 308 to download to the user's Internet client node 318 unrequested information such as *advertising repeatedly*".

Furthermore, Claims 1 and 13 require "wherein the provision of the advertisements is based upon . . . when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time", which is not taught or suggested in the combined teachings of Goldberg, et al. and Hall. The Examiner's Answer cites Hall at col. 3, line 55 to col. 4, line 5 as teaching or suggesting these limitations. Appellants disagree. Hall instead teaches "processing an order from a mobile customer comprises . . . identifying at least one facility capable of completing the order . . . [and] determining which facility of the at least one identified facility is capable of completing the order within the predetermined window of time coinciding with the customer's estimated time of arrival at the determined facility". There is nothing in this passage discussing advertising or the provision of advertising when a subscriber is within a predetermined distance of a predetermined vendor as is required by Claims 1 and 13.

With further regard to Claim 13, this claim requires the limitations of "requiring user interaction to determine whether an advertisement was reviewed", which is not taught or suggested in the combined teachings of Goldberg, et al. and Hall. In response to Appellant's Appeal Brief, the Examiner's Answer states at page 8 that "After carefully reviewing Goldberg, the Examiner wants to point out that Goldberg on col. 25, lines 30-48, teaches the advertisers can query the users to obtain feedback from the users regarding the advertisements, such as "**favorable and/or unfavorable responses**" regarding the advertisements viewed, therefore the responses to the advertisements is an acknowledgement that the advertisements have been viewed by the users". Appellants respectfully submit that this is a mischaracterization of the Goldberg, et al. teachings. This passage instead teaches a "query to the user and advertiser

databases . . . to obtain . . . feedback" (col. 25. lines 40-41). Thus, there is only an interaction by a system with a user *database* but no requiring of *user interaction* as is required by Claim 13.

Therefore, since limitations are missing from the combined teachings of the Goldberg, et al. and Hall references, a rejection of Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

B. Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall and further in view of Titmuss et al.

Regarding dependent claims 7 and 8, because claims 7 and 8 depend directly or indirectly from independent Claim 1, the appellants respectfully submit that claims 7 and 8 are not unpatentable over the prior art of record.

Regarding dependent claims 15 and 16, because claims 15 and 16 depend directly or indirectly from independent claim 13, the appellants respectfully submit that claims 15 and 16 are not unpatentable over the prior art of record.

For the reason set forth above, Applicants submit that the Examiner has incorrectly rejected Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. § 103(a) and request that the Board withdraw the rejections.

Respectfully submitted,

Steele, et al.

By: /Valerie M. Davis/

Valerie M. Davis
Attorney for Applicant
Reg. No.: 50,203
Phone: (847) 576-6733
Fax: (847) 576-0721